

REMARKS

The allowability of claims 13 and 14 is acknowledged appreciatively and accepted by combining claims 1 and 13 as new claim 15 with new claim 16 corresponding to claim 14 in dependence therefrom. Festo-like limitations should not arise from such combination despite some thinking to the contrary.

The rejections of claim 1 and, thus, the other dependent claims under 35 USC 102 for anticipation by the cited LeBlanc or DeSanto patents are traversed by amendment of claim 1 above to require the length of the wall member through which the duct extends to be greater than a transverse width (as well as height as previously claimed). This is clearly shown in Fig. 2, for example, and described at page 3, lines 5 and 6.

LeBlanc shows a duct 30 that extends transversely through a foundation. The duct is transverse and not longitudinal. This is clearly evidence from Figure 1 of LeBlanc where the duct 30 extends between two formwork members 40 and 42 that are used to form the foundation. Clearly the foundation is longitudinally elongated with a width far less than its length. The duct extends transverse and not longitudinal. Accordingly, LeBlanc fails to disclose the present invention since the foundation is not portable and secondly the duct does not extend longitudinally between opposite ends.

DeSanto fails for the above reasons in respect of LeBlanc. The duct extends transversely through the foundation and does not extend longitudinally. Accordingly, DeSanto fails to show a duct that extends longitudinally of a portable wall member.

Moreover, the rejections pay insufficient attention to the limitations of the Jepson preamble. The claimed invention is a wall member that is portable. The references do not disclose or suggest this. In Jepson or improvement claims:

The terms in both the preamble describing the prior art and those elements constituting the improvement are substantive claim limitations. 37 CFR § 1.75(e). Wells Mfg. Corp. v. Littlefuse, Inc., 192 USPQ 256 (7th Cir. 1976).

Nowhere do the Le Blanc and DeSanto patents disclose or suggest a wall member that is portable. Le Blanc is for a foundation. DeSanto is for a pressure relieving arch and, therefore, under the pressure producer.

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. ... (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim.") MPEP 2111.02 (citation omitted).

Even if the law were not followed that the preamble of a Jepson claim is a limitation, the claimed invention is still patentable as a new use for a device similar to but not the same as those of the references. The rule that no product patent may issue for a new use of an old product is tempered by the doctrine of slight changes. If the old product is altered, however slightly, to fit the new use, then there is no novelty bar. See, Chisum on Patents, § 1.03[8][b], where this is traced to Topliff v. Topliff, 145 US 156 (1892). In this case, the length difference is noted above. Then,

While the statute grants monopolies only for new structures, and not for new uses, invention is not to be gauged by the necessary physical changes, so long as there are some, but by the directing conception which alone can beget them. H.S. White v. Morton E. Converse & Son Co., 20 F.2d 311, 312-313 (2nd Cir. 1927).

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,



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